

No. 3715

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IN THE

United States

Circuit Court of Appeals,

FOR THE NINTH CIRCUIT.

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| Pacific States Electric Company, | } |
| <i>Appellant,</i> | |
| <i>vs.</i> | |
| William D. Wright, | |
| <i>Appellee.</i> | |

BRIEF ON BEHALF OF PLAINTIFF-APPELLEE.

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This case comes before this court on an appeal from an interlocutory decree adjudging claims 6 to 9, inclusive, of Letters Patent No. 1,214,486, issued on January 30, 1917, to plaintiff William D. Wright, valid and infringed.

Italics, wherever used herein, may be deemed ours.

Plaintiff is a resident of San Diego, California. Defendant Pacific States Electric Company is a distributor or dealer in electrical devices and is only a nominal defendant herein. The real defendant in interest is Landers, Frary & Clark, of New Britain, Connecticut, the manufacturer of the infringing de-

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Plaintiff is a resident of San Diego, California. Defendant Pacific States Electric Company is a distributor or dealer in electrical devices and is only a nominal defendant herein. The real defendant in interest is Landers, Frary & Clark, of New Britain, Connecticut, who are the authors of the infringing de-

vices; and that Company has assumed the defense of this case. [Rec. p. 67.]

The bill of complaint is in ordinary form in equity seeking an injunction and accounting. The answer challenges the validity of the patent in suit and denies infringement. The case was tried in open court before District Judge Oscar A. Trippet. Subsequent to the trial and before a decision, defendant obtained leave to file an English patent not offered at the trial. Thereafter the court filed a memorandum opinion [Rec. pp. 174-7] adjudging claims 6 to 9, inclusive, of the patent in suit to be valid and infringed. Pursuant to the opinion an interlocutory decree was entered awarding an injunction and accounting. [Rec. pp. 177-9.]

The Wright Invention.

It is a matter of common knowledge that within the last thirty years electrically heated household appliances have come into widespread general use. Electric heaters, sadirons, stoves, curling irons and the like are today familiar articles in every day use, whereas approximately thirty years ago they were unheard of.

One particular class of electrically heated appliances pertains to devices adapted for use on the dining room or breakfast room table. Every housewife appreciates the electric percolator, the electric toaster and the electric grill. By these appliances breakfast may be prepared at the breakfast table. The electrically heated appliance has the recognition of widespread use and needs no praise from us.

Although a housewife could prepare her coffee in an electric percolator, could make her toast on an electric toaster, and could fry her bacon and eggs on an electric grill, all on the breakfast table, it is a fact that prior to the Wright invention no one had ever produced an electric waffle iron adapted for table use. Prior to the Wright invention waffles had to be prepared in the kitchen. The common waffle-iron comprises a circular stand with a pair of pans hinged together.* Only one of these pans can be heated at a time. This required reversing the pans at the proper time to heat the opposite side of the waffle. Prior to the Wright invention there existed no electrically heated waffle-iron for table use.

In the fall of the year 1915 plaintiff William D. Wright was acting as floor manager in San Diego for a company selling household furnishings. [Rec. p. 69.] At that time Mr. Wright made certain experiments with a gas waffle iron in an endeavor to devise an iron wherein the heat would strike both sides of the iron at the same time; and thereupon the suggestion came to him of producing an electrically heated waffle iron. [Rec. p. 70.]

Mr. Wright thereupon carried forward his suggestion and about the first of November, 1915, completed the device constituting Plaintiff's Exhibit 3. [Rec.

*The common gas heated waffle iron is illustrated by Defendant's Exhibit 21 (a physical exhibit). There was one electrically heated waffle iron prior to Wright's invention which will be discussed hereafter; this iron was adapted only for restaurant use and re-

p. 72.] An examination of this exhibit 3 shows that it comprises a pair of box shaped casings pivoted together by a pair of hinges. Aluminum waffle baking surfaces or members are mounted in each of the casings. The surfaces of the aluminum waffle baking members extend over and cover the upper edges of the casings. This waffle iron is electrically heated by means of electric heating elements positioned adjacent the waffle baking members within the casings, and non-conducting elements insulate the electric heating elements from the casings. Both of the waffle baking members are simultaneously heated.

After completing his first electrically heated waffle iron Mr. Wright gave it to Mrs. Will Crane of San Diego and it was continuously used by her for baking waffles from the fall of 1915 until presented as an exhibit at the trial of this case. [Rec. pp. 74-5, 103-4.] Mrs. Crane testifies that she found the waffle iron, Exhibit 3, "Very, very satisfactory." [Rec. p. 104.] On December 9, 1915, Mr. Wright, through his attorney Mr. Rodabaugh forwarded a sketch of his waffle iron, Exhibit 3, to a patent attorney at Washington, D. C., with the request that an examination or search be made at the Patent Office to determine the patentability of the iron. [Rec. pp. 76-77.] A copy of this letter and the original sketch is in evidence as Plaintiff's Exhibit 4. [Rec. pp. 215-217.]

The waffle iron, Exhibit 3, is a double iron, that is to say, it bakes two waffles at a time. In December, 1915, Mr. Wright completed a smaller or single waffle

iron constructed along the identical lines of the iron, Exhibit 3. [Rec. p. 79.] This single waffle iron has been cut in half or cross-sectioned to disclose the interior construction and is in evidence as Plaintiff's Exhibit No. 6. The iron, Exhibit 6, was used as a demonstration iron. [Rec. p. 80.]

An examination of the iron, Exhibit 6, shows that it embodies the same novel features and principles of construction as are incorporated in the larger iron, Exhibit 3. There is a pair of casings pivoted together. Within these casings are aluminum waffle baking members or surfaces. These aluminum waffle baking surfaces cover the upper edges of the casings. Electrical heating means are positioned in the casings between the waffle baking members and the casings. The electrical heating means are insulated from the casings.

The structure of Exhibits 3 and 6, expressing and embodying Mr. Wright's invention, embraces:

- (1) A pair of casings pivotally connected together;

- (2) An aluminum waffle baking member or surface mounted in each casing; said waffle baking surfaces

- (a) Provided with flanges to cover the upper edges of the casings;

- (3) Electrical heating means positioned in the casings between the waffle baking members and the casings and insulated from the casings.

The foregoing structure presents to the art for the first time an electrically heated household waffle iron

adapted for table use. A waffle iron of such character must embody numerous distinctive characteristics and these are found in the Wright waffle iron as follows:

(A) An electric waffle iron for table use must be compact, light and neat in appearance . The common waffle iron comprising a circular stand with a pair of pans hinged together (Defendant's Exhibit 21) is obviously out of the question for table use. Prior to Wright no one ever conceived of making a waffle iron except by employing a cumbersome stand and a pair of pans revolvable on the stand. Wright conceived of substituting a pair of pivoted or hinged casings and mounting in each casing a waffle baking member in lieu of a cumbersome stand and revolvable pans. The Wright waffle iron has a neat box-like appearance. The provision of the box-like casings provides a structure which is compact and light. There are no unsightly excess parts.

(B) An electric waffle iron for table use must be so designed that it will properly heat without requiring more than an ordinary house current. The Wright waffle iron is the first electric waffle iron that will operate on an ordinary house current. It would be impossible to electrically heat the old style base and pan type of waffle iron on an ordinary house current. There would be so much current consumed in heating excess metal that the waffle baking surfaces would not be heated to a cooking temperature. The mounting of the waffle members in box-like casings in the Wright

waffle iron eliminates any excess metal to heat. All of the heat goes to the waffle baking members. To successfully operate with an ordinary house current it is necessary that the heat shall pass as directly as possible to the waffles being cooked and shall not be radiated and dissipated. In the Wright waffle iron the heat passes directly to the waffle baking members because the electrical heating elements are positioned on the under side of the waffle baking surfaces. Wright insured that the heat shall pass from the baking surfaces to the waffles with minimum loss by constructing the waffle baking members of aluminum. Aluminum is a rapid conductor of heat. [Rec. p. 99.] The heat will therefore pass directly to the waffle across the entire face of the baking member. The casings being of pressed steel, practically no heat will be dissipated.

(C) Any housewife who has baked waffles is familiar with the disagreeable task of greasing the old style waffle iron and the smoke that arises from the grease during the cooking. No waffle iron would be satisfactory for table use if it was necessary to grease the iron at the table with a consequent smoking up of the dining-room. The Wright iron requires no grease because of the aluminum baking surface. [Rec. p. 99.] In that connection particular attention is directed to the fact that each of the aluminum baking surfaces in the Wright waffle iron is provided with a flange which covers the upper edge of the casings. This aluminum flange performs a three-fold function in the device.

1. The aluminum flange prevents the waffle batter coming into contact with the upper surface (edge) of the casing to which it would stick in process of baking.

2. The aluminum flange prevents the batter from overflowing and running down between the baking member and casing, thus protecting the electrical heating element.

3. The aluminum flange acts as the principal support for the baking member within the casing.

Mr. Wright describes the functions of the aluminum flange as follows:

“A. It has three missions in being constructed in that form. One is that the continual opening and closing of the device, if it was simply supported by screws, would cause the entire waffle member to drop into the casing by the vibration loosening the screws and stripping the threads off the screws. It also prohibits the pastry from running out of the side and coming in contact easily with the metal surface that the pastry would adhere to. By the pastry adhering to the metal surface, it would make it difficult to remove the pastry from the iron. It also has a third purpose, of keeping the pastry and the oils of the pastry from running down into the element inside and arcing or shortening the element.” [Rec. pp. 98-99.]

It is apparent from the above that the Wright waffle iron is made up of a plurality of coacting elements. No one element alone is responsible for the proper functioning of the device. On the other hand, each element performs a necessary part of the whole and

the sum of their efforts makes possible the completed whole. The Wright invention is essentially a true combination of coacting elements. If any one element be eliminated the device fails. The employment of pivoted casings in lieu of a stand and revolvable pans is fundamental in the Wright device. The use of aluminum waffle members in combination with the casings economically and properly directs the heat to the waffle and is essential to table use on a house current. The aluminum flange performs a three-fold function and is necessary to the co-operation of the other elements. We will discuss the prior art specifically at another point herein. At this point we wish to reiterate that Wright was the first to produce an electrically heated waffle iron adapted for table use on an ordinary house current. In the combination of elements constituting the Wright device the following features will be found to be original with Wright and are not found in the prior art:

1. The design of the Wright waffle iron is fundamentally different from the prior art in that Wright employs box-shaped casings carrying the waffle baking surfaces as distinguished from the old style stand and revolvable pans.

2. Wright was the first to employ aluminum waffle baking members in an electric waffle iron, which in combination with the box-shaped casings provides a device that can operate on an ordinary house current.

3. Wright was the first to provide aluminum flanges on waffle baking members to cover the

upper edge of the casings containing the baking members and perform a three-fold function in the device.

Having completed and demonstrated the success of his waffle iron as exemplified in Plaintiff's Exhibits 3 and 6, Mr. Wright conceived the possibility of a further adaptation of this same invention. The thought came to him of also devising a composite device that would embody his waffle iron and also an electric grill. In other words, he determined to try attaching his waffle iron to an electric grill. [Rec. p. 77.] Accordingly in January, 1916, Mr. Wright constructed a composite device constituting Plaintiff's Exhibit 5. An inspection of this device shows that it includes every feature and advantage of Mr. Wright's waffle iron *per se*. Therein the waffle iron is annexed to an electric grill. In operation as a waffle iron, Exhibit 5 functions precisely as do Exhibits 3 and 6. The distinctive features of the box-shaped casings, and the aluminum waffle baking members mounted therein with flanges covering the upper edges of the casings, are all present in Exhibit 5. The operation of Exhibit 5 as a grill is entirely distinct from its use as a waffle iron. In brief, Exhibit 5 presents the not uncommon situation in patent law of a device embodying every attribute of an invention (the Wright waffle iron) to which has been added another separable feature or improvement (the electric grill).

The composite device Exhibit 5 was used with complete success as a waffle iron and was also successfully used to grill bacon, etc. [Rec. pp. 78-79.]

There are thus two aspects to the invention of Mr. Wright. Having conceived the fundamental or “generic” interrelation of elements, including the pivoted box-shaped casings with electrically heated aluminum waffle baking members having flanges covering the upper edges of the casings constituting his novel waffle iron, it was necessary for Mr. Wright to decide, according to his own judgment, upon the best *species* or form in which to express his generic “*idea of means*.”

Every invention comprises an abstract “idea of means” expressed in concrete form. There is no idea that cannot be expressed in a number of ways, each expression thereof being the equivalent of every other expression of the same idea. This is universally true. For instance, the idea that an object is round can be expressed in a number of ways. The same idea may be expressed thus: Every point on the object’s surface is equally distant from the center of the object.

Where an inventor conceives an idea of means it is always possible to express said idea of means in many different concrete forms. This is true in connection with mechanical inventions.

“A patentable invention is a mental result. The machine, process or product is but its material reflex and embodiment.”

Smith v. Nichols, 21 Wall. 112.

Exhibits 3 and 6 constituting the waffle iron *per se* and Exhibit 5 constituting the composite waffle iron and grill bear out the fundamental proposition that any invention may be expressed in a plurality of concrete forms. Both the waffle iron *per se* and the composite waffle iron and grill are specific expressions of Mr. Wright's generic conception of the primary interrelation of parts necessary for an electrically heated waffle iron adapted for table use. This primary interrelation of parts is present in each of these concrete forms and therefore the iron *per se* and the composite iron and grill are in fact, in the parlance of patent law, "species" of the "generic" invention. In other words, Mr. Wright has developed two different specific devices and each of these devices contains and is a concrete embodiment of his generic invention constituting the fundamental interrelation of parts necessary for an electrically heated waffle iron adapted for table use. Having his generic invention, and two specific concrete forms expressing that invention, we will next take up the manner in which Mr. Wright protected the same in the patent in suit.

The Patent in Suit.

Congress has recognized that every invention can be expressed in many different concrete forms. We, therefore, find in section 4888 of the Revised Statutes the following provision as to what an inventor must embody in his application for letters patent:

“* * * he shall explain the principle thereof and the *best mode* in which he has contemplated applying that principle, * * *.”

According to this section, an inventor is only required to describe, in his application for a patent, “one mode” of embodying his invention in concrete form.

The Patent Office rules are to the same effect and the Patent Office does not require and does not permit an applicant to include, in his application, every possible form in which his invention can be embodied.

In view of the foregoing, an inventor need only show in his patent his preferred form of embodiment of his invention. When he has done this, he is entitled *to claim his actual invention* in whatever form it can be embodied. As said by Judge Ross, in *Von Schmidt v. Bowers*, 80 Fed. 121, Judge Gilbert concurring:

“By section 4888 of the Revised statutes it is provided that every inventor, when making his application for a patent, shall file in the Patent Office a written description of his invention; and, if the application be for a machine, he is required to explain the principle thereof, and the *best mode* in which he has contemplated applying the principle, so as to distinguish it from other inventions. But he is not necessarily limited to the one mode shown. The pioneer inventor is entitled to a *generic* claim, under which will be included every *species* included within the *genus*. In addition to such *generic* claim, he may include in the same application specific claims for one or more of the species.”

The Wright patent in suit was framed pursuant to the above rule. [Rec. pp. 209-214.] Mr. Wright set forth in his description "one mode" in which he contemplated embodying his invention. He thereupon incorporated in his patent *generic claims* so drawn as to include "every species" employing his invention. The patent also contains "specific claims" limited to the particular *species* or embodiment depicted in the drawings. Mr. Wright sought by such generic claims to cover his generic conception of an interrelation of parts essential to the provision of an electrically heated waffle iron adapted for table use, and sought by the *specific* claims to cover his composite device comprising such waffle iron in combination with a grill member. This was a proper application of the doctrine of *generic* and *specific* claims.

For the purpose of illustrating "one mode" or concrete embodiment of his invention Mr. Wright annexed his patent drawings of the composite device, Plaintiff's Exhibit 5. In the specification of his patent Mr. Wright carefully and fully outlined the interrelation of parts essential to embody his conception of an electric waffle iron adapted for table use. Early in the specification appears the following paragraph:

"Another object of my invention is to provide a new and novel construction of waffle iron." [Rec. p. 211, lines 23-25.]

The interrelation of parts essential to the provision of an electrically heated waffle iron adapted for table use is described as follows:

“The waffle member b is preferably made of aluminum and may be of any shape desired, but my preferred construction is an oblong, rectangular shape. The member b is composed of an outer hollow casing n, which is preferably made of pressed steel and is provided with a recess or chamber sufficiently deep to contain the non-conductor n^1 , the heating element n^2 , the non-conducting element n^3 and the base portion of the metallic cooking surface member n^4 , all in the order in which I have enumerated same. The metallic cooking surface member n^4 is provided on its circumference with a projecting shoulder n^5 which rests upon and covers the edge of the casing n.” [Rec. 211, lines 68-83.]

“The member c is identical with member b in structure, composition and arrangement of its parts, hence I shall not describe the member c in detail.

Both of the members b and c are provided on their cooking surfaces with projections d^6 found in the ordinary waffle iron which are of a length so that they will have a space between their adjacent ends when the waffle surface of member c is placed on the surface of member b and the edges of members c and b are resting against each other, as shown best in Figs. 2 and 4.” [Rec. pp. 211-212, lines 95-3.]

The operation in baking waffles is described as follows:

“The waffle batter is poured on the cooking surface of the member b after which the member c is revolved on the hinges r and s until its cooking surface is directly above the cooking surface of the member b and the edge of the cooking member n^4 rests upon the edge

of the similar cooking member of the member b.”
[Rec. p. 212, lines 111-118.]

* * * * *

“By reason of both waffle cooking surfaces being made of aluminum no lubrication is required on the said cooking surfaces and the waffles are cooked evenly on both sides at the same time.” [Rec. p. 212, lines 125-129.]

At the end of the specification to his patent Mr. Wright emphasized that the specific device illustrated in the drawings was only one form in which his invention might be embodied and that he did not intend that his patent should be limited to that specific form, by stating:

“Although I have described my improvements with considerable detail and with respect to certain particular forms of my invention, I do not desire to be limited to such details, since many changes and modifications may well be made without departing from the spirit and scope of my invention in its broadest aspect.”
[Rec. p. 213, lines 32-39.]

In *Kings County Raisin & Fruit Co. v. U. S. Consol. S. R. Co.*, 182 Fed. 59, this court construes such a statement as showing under the patent law that the inventor intends to cover thereby the broad aspect of his invention and not to limit himself to the specific form illustrated in his drawings.

Pursuant to the doctrine of *genus* and *species* and in accordance with his avowed intent not to limit his patent to the particular form shown in the drawings, Mr. Wright made in his patent two distinct sets of

claims. The first of these sets constitutes claims 1-5, inclusive. Each of the claims of the first set includes the “grill member” and these claims are *specific* and drawn to protect the particular form of device illustrated in the drawings of the patent.

The second set of claims comprises claims 6-9, inclusive. These latter claims are *generic* and as stated by this court in *Von Schmidt v. Bowers (supra)* these generic claims cover “every species included within the genus.” All reference to the grill member is omitted from claims 6-9. These claims recite the elements essential to provide an electric waffle iron adapted for table use, and omit everything else that is not essential for such purpose.

As claims 6-9 are the only claims in suit, we shall confine our attention to these claims. In order that the meaning and scope of the claims under consideration may be apparent to the court we shall set forth in outline claim 6 and thereafter refer to claims 7-9 in so far as the latter differ from claim 6. Claim 6 is perhaps the broadest of the claims and includes, “In a device of the class described,

(1) A pair of casings pivotally connected together,

(2) A waffle member provided with an aluminum baking surface mounted in each of said casings so that each of said aluminum baking surfaces covers the upper edge of one of said casings, and

(3) Means mounted in said casings between said casings and said waffle members for electrically heating said waffle members.”

It is apparent from a study of claim 6 that it covers precisely those elements and features which, as we have seen above, comprise the essential elements and features of Mr. Wright's *generic* conception of an electrically heated waffle iron adapted for table use. The claim recites the fundamental conception of a pair of pivotally connected casings with waffle baking members or surfaces mounted in the casings. The claim then states that these baking surfaces shall be of aluminum. The claim expressly provides that the aluminum flange covers the upper edge of the casing in which the baking member is mounted. In the last clause the claim broadly calls for means mounted in the casings for electrically heating the waffle members. A comparison of this claim with the Wright waffle iron Exhibits 3 and 6 and with the composite Wright device Exhibit 5 will demonstrate that the claim may be read on both specific forms in which Mr. Wright embodied his generic invention. *Claim 6 likewise describes defendant's infringing device, Plaintiff's Exhibit 2 with absolute accuracy.*

Claim 7 differs from claim 6 in two respects only. Whereas claim 6 states "that each of said aluminum baking surfaces covers the upper edge of one of said casings," claim 7 provides that the surfaces of the aluminum baking members shall "extend past the edges of said casings." Claim 7 more particularly describes the electric heating means broadly mentioned in claim 6, by stating that the same consists "of an electrical heating element adjacent said waffle member and a non-

conducting element spacing said electrical heating element from said casing.”

Claim 8 differs from claim 6 by describing the casings as “box-shaped” and connected “so as to fold one upon the other.” Claim 8 does not specify that the waffle members shall be of “aluminum,” but states that such members are provided with outwardly extending flanges “whereby said waffle members are supported on the edge of said casing and spaced apart from the bottom thereof.”

Claim 9 is identical with claim 8 except that claim 9 defines the electrical heating means in the same manner as does claim 7.

It is apparent from the above that claims 6-9 are generic claims which apply equally to the two specific forms in which Wright embodied his generic invention, *i. e.*, the waffle iron *per se* and the waffle iron in combination with the grill. The court will readily perceive the generic character of these claims 6-9 by comparing them with claims 1-5. The latter claims include as an element the grill member and parts and features pertaining to the grill member. Claims 6-9 contain no reference whatever to the grill member. Under these circumstances claims 6-9 are in law generic claims and cover any form or species embodying the interrelation of elements recited in such generic claims. This doctrine is established by this court in the case of Los Angeles Art Organ Co. v. Aeolian Co. *et al.*, 143 Fed. 880, 884.

“Tremaine & Pain made three generic claims for ‘mechanism controlled by each music sheet to regulate and control the movement of the other music sheet.’ *This included the numberless species in which the skilled mechanic or future inventor might embody their creation.* The other claims were for more specific features and elements.”

Appellant’s brief is based entirely upon a false theory that the specific structure illustrated in the drawing of the Wright patent defines the metes and bounds of the scope of the patent. To the contrary, as stated by this court in *Henry v. City of Los Angeles*, 255 Fed. 769, quoting from the Supreme Court:

“It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor.”

Appellant’s brief ignores the elementary distinction between generic and specie claims. In proceeding upon this false premise appellant has advanced several propositions that are totally unsound when considered in the light of the rule thus ignored. For example, we refer to appellant’s treatment of the phrase “pivotally connected together” in claims 6-9. At the bottom of its brief, page 7, appellant states that this phrase does not mean merely hinged together, but means a particular style of connection wherein the lower waffle member may be reversed. There is absolutely nothing in claims 6-9 to support this proposition. Obviously the pair of hinged members in Plaintiff’s Exhibits 3 and 6 are

pivotally connected together. Likewise the members of defendant's infringing devices, Plaintiff's Exhibit 2, are pivotally connected together. Indeed, this is expressly admitted in the testimony of Mr. Lamb, defendant's chief witness and vice-president of Landers, Frary & Clark.

"XQ. 130. Now, the waffle irons manufactured and sold for your company include a pair of casings pivotally connected together, do they not?

A. They do." [Rec. p. 56.]

Appellant bases its contention solely on the specific form illustrated in the patent drawing. The obvious answer is that claims 6-9 are generic claims, and being expressed in terms including all embodiments of the generic invention are not limited to details of the form illustrated in the drawings, as to which details the claims are silent.

Of like import is the contention made at page 24 of appellant's brief that unless the phrase "pivotally connected together" in claims 6-9 be construed to mean a particular style of connection wherein the lower waffle member may be inverted, the claims would be invalid because of inoperativeness. This contention is an outgrowth of the false proposition that the specific device illustrated in the patent drawing is the only one embraced in the patent. The doctrine of generic claims is ignored. As a matter of fact if the waffle members be directly hinged together the resultant device constituting the combination of elements expressed in claims 6-9 functions perfectly for baking waffles. This is

demonstrated by Plaintiff's Exhibits 3 and 6, which comprise the precise elements of claims 6-9. The phrase "pivotally connected together" is a broad phrase. It is not as restricted as would be the phrase, pivotally connected together through a grill member. Nor is it as restricted as would be the phrase, pivotally connected directly together. The phrase of claims 6-9 includes both of these latter phrases and is a true example of genus and species. In other words, two members are pivotally connected together both when they are pivotally connected *directly* together and when they are pivotally connected *indirectly* together through a third member.

A further proposition advanced by appellant is that the introductory phrase of claims 6-9 "in a device of the class described" and the title of the patent "Electric Cooking Apparatus" limits the scope of generic claims 6-9 to the specific form illustrated in the patent drawings. We are utterly unable to perceive any logic in such contention. Obviously the subject matter of claims 6-9 is a waffle iron and certainly a waffle iron may be properly classified as an "Electric Cooking Apparatus." We have heretofore pointed out that the patent fully describes the details and purposes of the generic interrelation of elements defined in claims 6-9. We will risk repetition by again quoting from the patent as follows:

"Another object of my invention is to provide a new and novel construction of waffle iron." [Rec. p. 211, lines 23-25.]

Furthermore it is well settled that the scope of claims 6-9 must be determined by the elements recited therein and cannot be limited by an introductory phrase. As said by the Circuit Court of Appeals for the Sixth Circuit in *W. W. Sly Mfg. Co. v. Russell & Co.*, 189 Fed. 61 at 65:

“The mere use of the word ‘crusher’ in the amended claim is by no means conclusive of an intent to limit the protection of the patent to the crushing feature. The introductory phrase is not an element of the combination, and does not necessarily limit the claim. *Ex parte Casler*, 90 Off. Gaz. Pat. Off. 446.”

We submit that Mr. Wright fully conformed to the law by illustrating in his patent one specific form embodying his invention and that he properly set forth in his patent generic claims 6-9 covering all specific forms in which his generic invention might be expressed, thereby fully protecting his waffle iron *per se* and his composite device as intended.

The Prior Art.

Defendant urges that the Wright patent is invalid in view of certain prior patents and devices offered in evidence. These patents and devices cover a period of over twenty years prior to the Wright invention. One of these prior patents was issued in England twenty-two years before Mr. Wright applied for the patent in suit. Obviously defendant has combed the entire prior art with a fine-tooth comb in an endeavor to find an

anticipation of the patent in suit. From a mass of antecedent material defendant has selected the best that existed. This selection was made with the Wright invention in front of the searcher. To aid him, the searcher had that knowledge which is cheapest of all knowledge—*knowledge after the fact*. It is a tribute to the Wright invention that the search failed utterly to find an anticipation. We assert without fear of contradiction that no prior patent or device was found that discloses the elements of Mr. Wright's generic invention recited in claims 6-9.

Under these circumstances appellant has resorted to the time-worn path which constitutes the only path open to the infringer who has no actual anticipation. That path is to mentally reconstruct the prior art in an endeavor to build up in the mind of the court a hypothetical prior art which never *in fact* existed. This is attempted by relying upon one prior patent for one feature, another patent for another feature, and so, by a combination and reorganization of prior patents and devices, build up in the mind a hypothetical device which it is contended, *if it had existed*, would render invalid the patent in suit. But the courts have repeatedly held that a non-existent hypothetical device existent only in the mind for the occasion of the suit is no defense whatsoever. This court so held in *Los Alamitos Sugar Co. v. Carroll*, 173 Fed. 280:

“It is not sufficient to constitute anticipation that the devices relied upon might, by a process of modification, reorganization, or combination with

each other, be made to accomplish the function performed by the device of the patent sued on."

As said by Judge Coxe in *Johnson v. Forty-second Street, M. & St. N. Ave. R. Co.*, 33 Fed. 499, 501:

"Of course the accusation that the separate elements of the combination were old is of no moment. *It would be as irrational to charge an author who has produced a sentence of surpassing power and beauty with plagiarism, because the words which he employs have long been found in the lexicon, as to overthrow a patent for a new and useful combination upon the ground that its separate elements are old.* By an ingenious assembling of known appliances this inventor solved the problem the solution of which had been sought for in vain through a long series of years. Although the goal was frequently in sight, it had never been reached; *always some necessary requisite to success was lacking.* The practical disentanglement of the difficulty was left to Newman. He made that a success which before had been tentative and rudimentary. In judging of the invention care should be taken not to underestimate its value, because the apparatus, now that we have seen it work, seems so plain and simple. The test to which this patent has been subjected,—the test which is usually applied to all contested patents,—is certainly severe, and is often misleading and deceptive.

"The defendant assembles every similar device, description, or suggestion in the particular art not only, but also in analogous, and even in remote arts. Everything which has the least bearing upon

the subject is brought in and arranged by a skillful expert in an order of evolution which resembles most closely the invention which is the subject of attack. Having thus reached a point where but a single step, perhaps, is necessary to success, and knowing from the inventor exactly what that step is, the expert is asked if the patent discloses invention, and, honestly, no doubt, answers in the negative. There is always the danger, unless care is taken to divest the mind of the idea added to the art by the inventor, that the invention will be viewed and condemned in the light of ascertained facts. *With his description for a guide, it is an easy task to trace the steps from the aggregation to the invention.* When it is remembered that before Sir Humphrey Davy made his safety-lamp, wire gauze, and lanterns provided with perforated tin cylinders, were well known, it seems in the light of the present as if the idea of substituting the gauze for the perforated tin, being apparently so simple, might have occurred even to a skilled mechanic. So, too, moving the eye from the head to the point of a needle seems, in this age, but a trifling thing; and yet, to the inspiration of genius which suggested these changes we are indebted for two inventions of inestimable value. Carrying the mind, therefore, back to 1871, and judging his combination in the light of what was then known, it is thought that Newman's contribution to the art places him upon the plane of the inventor. What he did was not so obvious a change that it would have occurred to a skilled artisan."

To the same effect are the following words of Lord Justice Moulton, in rendering the decision of the Court

of Appeals in the case of Minerals Separation, Limited, v. The British Ore Concentration Syndicate, Limited, *et al.*:

“The industrial and scientific problems which face mankind are being attacked all over the world by busy, inventive minds from the most varied points of view. When some lucky inventor has been successful in solving the problem and (whether for the purpose of action or otherwise) the records of past failures or incomplete success are searched, it is common to find that suggestions or adumbrations of each of the various steps by which he has achieved his result are to be found in some one or other of the works of those who have gone before him, and when such records are selected from a mass of antecedent publications and put in an isolated form before a court, there is a danger of their giving rise to a suspicion of a general lack of novelty in the successful invention. *But it must be remembered that these alleged prior publications are the product of a selection made with a knowledge of the successful invention, and that probably hundreds of proposals equally promising, but which point in wholly different directions, have been rejected in the search by reason that they do so.* It is somewhat as though one were to decry the merit of a prospector who had discovered that sands were auriferous by showing that after due rejection of most of the non-metallic particles from a handful of sand the gold may be made to appear visible to the naked eye.”

“The presumption of invention is not overcome by the fact that an expert is able to build up the patented device by selecting parts taken from the prior art.”

Kryptok Co. v. Stead Lens Co., 207 Fed. 85.

We do not understand that appellant has had the temerity to maintain that any prior patent or device discloses the combinations of the elements recited in claims 6-9 in suit, but whether maintained or not, it is perfectly obvious that no such prior patent or device existed.

The Crompton Patent.

This patent was issued in England and bears date of May 19, 1893. [Rec. pp. 169-171.] The device illustrated in the Crompton patent is not a waffle iron and cannot be used for baking waffles. The patent states that the Crompton device is to be used for “grilling or broiling meat, toasting bread, grilling slices of pudding,” etc. The device is an electrically heated stove. Its resemblance to the Wright invention is more superficial than real and is due to the fact that the heated “plate” is mounted in a casing and covers the upper edge thereof. But there is only one of these casings. The patent states that a “lid” ^a may be added to the plate. The patent drawings illustrate in dotted lines a hinge for connecting the lid to the plate. This hinge is so designed and proportioned that it will support the lid considerably above the plate and leave between the lid and plate an open space. This open space will be

equal approximately to the height of the casing. This open space renders the device totally unfit for baking waffles, because in cooking the waffle batter would escape between the plate and lid.

Crompton had no conception of the fundamental principles of design upon which the Wright invention is based. The thought of producing a waffle iron by substituting a pair of pivotally connected casings with waffle baking members mounted therein, in lieu of the old style circular stand and reversible pan type of waffle iron, is in no manner disclosed in the Crompton patent. Although Crompton illustrated a *single casing* containing an electrically heated plate, Crompton did not suggest or conceive that this principle of design might be applied to a waffle iron. It is apparent that Crompton had no conception of forming a waffle iron by mounting the waffle members in a *pair* of pivotally connected casings. The latter is a radical departure from the common design of waffle iron and was a matter entirely outside the mind of Crompton and his patent is totally silent thereon.

Nor did Crompton conceive or disclose electrically heated aluminum waffle baking members covering the upper edge of the casings. We have heretofore pointed out the prime importance of that construction in the Wright waffle iron. It underlies the fitness of the device for table use. The efficient conductivity of aluminum enables the device to operate on a house current. It permits the device to be used at the table by eliminating a necessity for greasing. All of this was first

conceived by Wright and was totally unthought of and undisclosed by Crompton.

The Crompton device therefore fails to disclose the combination of elements constituting the Wright invention in the following fundamental particulars:

(a) Crompton does not show a pair of casings pivotally connected together.

(b) Crompton does not show waffle members mounted in the casings.

(c) Crompton does not disclose forming the waffle members and flanges covering the upper edge of the casings of aluminum to enable economical consumption of electric current and to eliminate the necessity of greasing the iron.

We have heretofore pointed out that the Crompton device will not bake waffles or perform the novel function of the Wright invention.

As the Crompton patent does not disclose the combination of elements of the claims in suit, it is elementary that the Crompton patent is not a valid anticipation. In the words of Judge Coxe (*supra*):

“Of course the accusation that the separate elements of the combination were old is of no moment.”

Perceiving that Crompton does not disclose the combination and will not perform the function of the Wright invention, appellant has resorted to the suggestion that the Crompton device *might* be altered and reorganized to meet the claims in suit by substituting

a waffle baking member for the plate a, substituting a second casing and a waffle member for the lid a^x, substituting a hinge of proper proportions to enable the casings to meet, and forming the waffle members of aluminum. As appellant has likewise suggested that each of the other prior patents and devices "might, by a process of modification, reorganization, or combination with each other, be made to accomplish the function performed by the device of the patent sued on," we will postpone discussing such unsound contention until we can discuss the same with reference to all the prior art.

The Crompton patent bears date of May 19, 1893, approximately twenty-two years prior to the time when Wright conceived his invention. During all these years no one derived from the Crompton patent any suggestion of the Wright invention. It was only after the trial of this case in the lower court that even appellant discovered any resemblance between the Crompton patent and the Wright invention. [Rec. p. 162.] We believe it perfectly obvious that appellant's contention as to what might be spelled out of the Crompton patent without the necessity of invention is completely overthrown by the fact that such "spelling out" waited twenty-two years for the invention of Mr. Wright.

In judging this Crompton patent it should be borne in mind that it is a foreign patent. The law is well settled that a foreign patent is effective as an anticipa-

tion only to the extent of actual features clearly and exactly described.

Seymour v. Osborne, 11 Wall. 516, 555, 20 L. Ed. 33;

Berry v. Wynkoop etc., 84 Fed. 646, 651, 28 C. C. A. 505;

Westinghouse v. Great Northern, 88 Fed. 258, 263, 31 C. C. A. 525;

Consolidated v. West End, 85 Fed. 662, 665, 29 C. C. A. 386.

At page 32 of appellant's brief appears a reference to a model of the Crompton device. No model was offered in the trial court and apparently appellant will present a model for the first time at the argument before this court. We have never seen the model, if any has been prepared, and are unable to compare it with the Crompton patent to determine if it is a correct representation thereof. We do know that appellant presented to the trial court a supposed model of the device illustrated in the Capek patent in evidence. This model did *not* illustrate correctly the device as described in the Capek patent, but constituted a hypothetical device that embodied the reconstruction of and addition to the Capek patent suggested by appellant. As appellant has suggested numerous changes in the Crompton device to enable it to serve the purpose of an anticipation, it is possible appellant has done as with the Capek model, to-wit, prepared a model not of the Crompton patent, but of a hypothetical device that

never existed except in the mind of appellant's attorney. In fairness we ask that the court use the specifications and drawings of the Crompton patent in lieu of a model not of record. As said in *Western Electric Co. v. Home Tel. Co.*, 85 Fed. 649:

“To change this record, by permitting theoretical modifications of these earlier patents, would be the same, in principle, as to change, by interpolation or modification, any other evidence between the parties.”

The Lamb Patents and Devices.

Appellant has offered in evidence five patents covering electrically heated cooking devices designed by its witness Mr. Lamb, the vice-president of Landers, Frary & Clark. [Rec. pp. 243-263.] These patents illustrate electric chafing-dishes, electric percolators, electric irons, and electric vessels. Appellant also offered in evidence an electric percolator, an electric chafing-dish, an electric stove, together with two electric irons. (Defendant's Physical Exhibits 4-10.) None of the patents or devices shows or constitutes a waffle iron. These devices are all designed for table use. The devices were developed and the patents applied for in 1912. The appellant has thereby established a very significant fact and a fact that cannot be reconciled with its attempt to belittle the Wright invention. Defendant has thus shown that in 1912 it was developing as far as it could a complete line of electrically heated cooking appliances for table use; but did

electrically heated waffle iron for table use. It was admittedly not until after the Wright invention that the infringing device was conceived. Acts speak louder than words. The Lamb patents and devices prove that prior to Mr. Wright's invention an electrically heated waffle iron adapted for table use was unthought of and unknown. The Lamb patents are cogent evidence that defendant and Mr. Lamb consider different electrically heated devices to be individually patentable. We are confident that if Mr. Lamb had produced defendant's infringing waffle iron in 1912 with the other devices patented by him, that defendant would have patented the waffle iron at the same time as the other patents were procured and would now be vigorously asserting the validity of the patent.

Appellant's brief does not specifically discuss the pertinency of any of the Lamb patents except No. 1,060,265. [Rec. pp. 253-256.] This patent illustrates in Fig. 5 of the drawings an electric stove. The only thing appellant can find in common between that patent and the Wright invention is the fact that the cooking surface is mounted on a casing and covers the upper edge thereof. There is no suggestion in the patent of the desirability or the possibility of utilizing even that single feature in an electrically heated waffle iron. The Lamb patent discloses none of the other elements embodied in the Wright invention and patented in claims 6-9 in suit. The Lamb patent shows nothing except that one element of the Wright combination is old. Under elementary principles of patent law the fact

that one element is old or even that all the elements of a combination are separately old does not invalidate a patent for a combination. As said by the Circuit Court of Appeals for the Second Circuit in *H. Ward Leonard, Inc., v. Maxwell Motor Sales Corporation*, 252 Fed. 584 at 593:

“The specification of a mechanical combination patent generally discloses a machine consisting of a large number of elements, most of them individually old in the art.”

The combination is a separate entity from its component parts and it is immaterial whether the elements of the combination are separately old or new. We will not burden this court by duplicating citations of this and other courts as to this familiar rule. The principle is stated by the Supreme Court in *Leeds & Catlin Company v. Victor*, 213 U. S. 325 at page 332, as follows:

“A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single or non-composite instrument. Whoever uses it without permission is an infringer of it.”

The Capek Patent.

This patent is for an electrically heated vessel and was issued on March 14, 1893. [Rec. pp. 265-270.] Capek had no conception of an electrically heated waffle iron or how to make one and his patent is totally silent thereon. The only thing of which Capek was aware was

Wright invention is restricted to the arrangement outlined in Fig. 7 of the Capek patent drawings. That arrangement is composed of an outer "vessel" 26 [Rec. p. 269, line 39] and a "cover" 45. [Rec. p. 269, line 89.] The outer vessel and cover are connected by means of a complicated hinge construction designated 42, 44 in the drawing. An "inner vessel" 1 is positioned in the outer vessel 26 and a duplicate "inner vessel" 47 is positioned in the cover 45. [Rec. 269, line 93.] Electric heating elements are annexed to the bottom of the inner vessels and are indicated in figure 7 by 18 and 46, respectively.

Figure 7 clearly indicates that the "inner vessels" are bowl-shaped and of considerable depth. This renders the device totally unfit for baking waffles. Of course, Capek had no thought of how to construct a waffle iron and, therefore, the bottoms of the vessels are not formed with the required waffle forming projections. But that is not the greatest difficulty in the way of baking waffles with the Capek device. If waffle batter was placed on the bottom of the inner vessel 1 and the cover folded over there would be so great a distance between the two heated surfaces that the waffle batter could not possibly contact with the upper surface to bake and form. Fundamentally the Capek device cannot function as a waffle iron for the same reason as any kettle cannot be said to be a waffle baking member.

In addition to being fundamentally unsuited in design for baking waffles the Capek device lacks essen-

tial elements of the combination of the claims in suit. The Capek device has no waffle baking members or surface as called for by claims 6-9 of the Wright patent. The Capek patent makes no suggestion of forming waffle members of aluminum, which is necessary in a waffle iron adapted for table use to economize on current and eliminate greasing.

Appellant appreciates that the Capek device as illustrated in figure 7 of the Capek patent does not contain the Wright combination and cannot perform the function of the Wright invention. Therefore, in presenting an asserted model of the Capek device appellant has not presented a model constructed according to the Capek patent, but has reorganized and reinvented the Capek device to show how it *might* have been but was not made to meet the Wright invention and function as a waffle iron. This hypothetical model constitutes Defendant's Exhibit No. 17. In reference to this model it should be remembered that it is not a model of the Capek device as illustrated in the patent. It is a model of a device that never existed in the prior art at all. In the model has been incorporated features that were first invented by Mr. Wright and the maker of the model got his knowledge of those features from the patent in suit. In other words, the model was one of those "illustrative" propositions prepared solely for the purpose of the suit. In fact, it illustrates the thing that did not exist in the art prior to the Wright invention. This was made clear by the trial court to whom counsel for appellant stated, "It was just made

up for this case.” [Rec. p. 133.] The model differs from the device illustrated in figure 7 of the Capek patent in substituting waffle baking members for the inner vessels, and by making the cooking surfaces approximate the juncture of the outer vessels so that the two waffle members will be spaced properly from each other in operation. A practical hinge has been substituted for the arrangement illustrated in the Capek patent. The model as submitted does not have the waffle members made of aluminum and lacks the electric heating means included in the Wright combination.

It may appear to us now that the aforesaid alterations are simple. But they are simple to us because we have first had their possibility demonstrated to us by observation of the Wright invention. Until Mr. Wright made his invention no one perceived any of the possibilities in the Capek device urged by appellant to be so obvious. The Capek patent was issued in 1893 and during the more than twenty years between its issuance and Mr. Wright's invention no one gained from the Capek patent a disclosure of the waffle iron in issue. *In 1912 when defendant Landers, Frary & Clark was bringing out its line of electrically-heated appliances for table use it saw no such possibilities in the Capek patent, which was then twenty years old.* The lapse of twenty years during which the Capek patent laid dormant is ample to establish that it did not suggest what is urged by appellant. With regard to a similar situation, the Circuit Court of Appeals for the

Seventh Circuit, in *Faries v. Brown & Co.*, 121 Fed. 546, at 550, said:

“The advance seems simple enough. One wonders why, pending its adoption, twelve years went by. But the same wonder accompanies every step forward in the useful arts. The eye that sees a thing already embodied in mechanical form gives little credit to the eye that first saw it in imagination. But the difference is ‘just the difference between what is common observation and what constitutes an act of creation. The one is the eye of inventive genius; the other of a looker on after the fact.”

The Simplex Iron.

A specimen of this device constitutes Defendant's Exhibit 1 and the same is illustrated in a catalog of the manufacturers dated April 12, 1904. [Rec. pp. 227-230.]

The Simplex iron was the only electrically heated waffle iron that existed prior to the Wright invention. Admittedly the simplex iron will not perform the function of the Wright iron and is more expensive in manufacture. Before discussing these differences in function and cost we will outline the differences in design responsible for the same.

The Simplex iron is formed with a large metal stand. This metal stand is provided with two sets of cavities to receive the waffle baking members when the same are in open or unfolded position. During the baking operation half of this stand is useless. It is apparent

that the one who designed the Simplex iron never got out of sight of the old-fashioned stand and revolvable pan arrangement. The idea of the neat and simple box-like formation presented by the Wright invention wherein the entire iron and component parts are included within a pair of folding casings, is a radical departure from the Simplex iron as well as from the old gas iron like Defendant's Exhibit 21, Griswold iron. The Simplex iron also lacked the aluminum baking surfaces and, of course, having a stand instead of folding casings, did not provide flanges covering the upper edges of the casings. The Simplex iron does not, therefore, contain the elements included in the combination of claims 6-9 in suit.

The cumbersome design of the Simplex iron involved so much metal and so inefficiently distributed the heat that the device requires more than an ordinary home current for operation. It is adapted for restaurant use only. The Simplex iron is a more expensive iron to manufacture than one made in accordance with the Wright invention. Mr. Lamb admits that the Simplex iron is not adapted for table use, as it will not operate on a house current and is more expensive to manufacture:

"A. * * * It would be impossible to produce the Simplex iron at the same price and it could not be used in the same way.

RXQ. 176. Why not?

A. Because it takes more current than goes on a lamp socket." [Rec. p. 65.]

Since the Simplex iron does not contain the combination of elements in the claims in suit and will not perform the function of the Wright device, it is elementary that the Simplex iron is not an anticipation.

“It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, *if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions.*”

Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658 at 661.

“It Is Much Easier to Add Than to Invent.”

Appellant is unable to show any prior patent or device upon which claims 6-9 of the patent in suit may be read. Therefore, appellants have resorted to relying upon one prior patent for one feature, another prior patent for another feature, and so, by a method of reorganization and combination of prior patents and devices build up in the mind only, a device which, *if it had existed*, might invalidate the Wright patent.

For example, appellant asserts that the Crompton patent illustrates a cooking surface mounted in a casing covering the upper edge thereof, that the Capek patent illustrates a pair of pivotally connected casings, that the Simplex iron illustrates a waffle iron having a pair of electrically-heated waffle baking members and that the Griswold iron has aluminum baking surfaces. Thereupon appellant urges that the Wright patent is

might be gathered together and combined the elements necessary to form the Wright invention. Appellant then urges to the court that such gathering together is so obvious that the decree of the trial court should be reversed and the Wright patent held void for lack of invention.

The test the court is asked to apply is very unfair both to the court and to the inventor. The court is required to judge the mental process involved in the production of the invention, but the court cannot view the problem except *ex post facto*. The inventor created the invention out of his imagination. The court is deprived of imagination because it has first examined the completed invention. It was one thing to *create* the combination of elements and features; it is an entirely different thing to view a number of prior patents and see if there exists the elements which might be added together to comprise the combination. Courts have long recognized this difference. In 3 Coke's Institutes 184 we find the statement:

"It is much easier to add than to invent."

In final analysis the assertion of appellant in this case is that because it seems easy to *add* the elements together from the prior art, Wright made no invention. This is a very unsound proposition and if accepted would constitute an extremely dangerous precedent. This court in *Stebler v. Riverside Heights Orange Growers Association*, 205 Fed. 735, 738, unequivocally overruled the same contention:

“True, we may pick out one similarity in one of these devices, and one in another, and still one in another, and, by combining them all, anticipate the inventive idea expressed in the Strain patent, but the combination constituting the invention is not found in any one of them. As we had occasion to say in Los Alamitos Sugar Co. v. Carroll, 173 Fed. 280, 97 C. C. A. 446:

“‘It is not sufficient, to constitute an anticipation, that the devices relied upon might, by a process of modification, reorganization, or combination, be made to accomplish the function performed by the device of the patent.’ Western Elec. Co. v. Home Tel. Co. (C. C.), 85 Fed. 649; Topliff v. Topliff, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658; Gunn v. Bridgeport Brass Co. (C. C.), 148 Fed. 239; Ryan v. Newark Co. (C. C.), 96 Fed. 100; Simonds R. M. Co. v. Hathorn Mfg. Co. (C. C.), 90 Fed. 201-208; Gromully & J. Co. v. Stanley Cycle Co. (C. C.), 90 Fed. 279; Merrow v. Shoemaker (C. C.), 59 Fed. 120.” (Italics ours.)

We believe this court has always followed the rule in the Stebler case and that there is no question but that it is the established law of this country.*

* For other cases to the same effect see, for example, *Bates v. Coe*, 98 U. S. 31, 48, 25 L. Ed. 68; *Topliff v. Topliff*, 145 U. S. 156, 36 L. Ed. 658; *Disc Grader & Plow Co. v. Austin-Western Road Machinery Co.*, 254 Fed. 430 at 433 (C. C. A. 8th); *Stromberg Motor Co. v. Zenith*, 254 Fed. 68 at 75 (C. C. A. 7th); *St. Louis v. American*, 156 Fed. 574 (C. C. A. 8th).

In *Wire Wheel Corporation v. Madison Motor Car Co.*, 267 Fed. 220, the court said:

“It is not difficult, after a problem has been solved, to take patent after patent, pick one feature from one patent, and another from the next, and then say the completed product is so near the patented product that the final step constituted but the work of a mechanic. But invention cannot be so determined. Rather must the mark of distinction fall on him who, appreciating both the means and desired ends, conceives of a relation of elements, old or new, in whole or in part, that will produce the desired results. It is quite immaterial if, after the conception is announced, the skilled mechanic readily understands it, or with slight or no difficulty builds the new device by practices or means well known to his trade.”

The fact that it now seems simple or even obvious to combine the various elements to provide the combination of the claims in suit does not establish non-invention. As said by this court in *Doble v. Pelton Water Wheel Co.*, 186 Fed. 526:

“Simplicity of a device is no evidence of want of invention nor obviousness, but in such cases the question of patentability may, and in many cases must, be determined largely from the results obtained.”

Again in *Snow v. Kellar-Thomason Co.*, 241 Fed. 119-123, this court said:

“True, the discovery was exceedingly simple, and it is an object of wonder why everybody, or at least every mechanic, did not appreciate the

mechanical effect. Yet it is true that no one seems to have known it. But because the contrivance appears simple after it has been once developed affords no absolute reason why it lacks novelty. Indeed, the most simple contrivances sometimes present the clearest examples of the product of inventive faculty, and we quite agree with the learned district judge that the present device involves invention. 'It involves that which is new in the art, the last step, as it has been termed.' See *Gandy v. Main Belting Co.*, 143 U. S. 587, 12 Sup. Ct. 598, 36 L. Ed. 272."

It is easy for appellant to urge that this or that does not involve invention, but the Supreme Court of the United States has said:

"It possesses such amount of change from the prior art as to have received the approval of the Patent Office, and is entitled to the presumption of invention which attaches to a patent. Its simplicity should not blind us as to its character. Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and, 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl v. Ocean Mills*, 2 Bann. and Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. *Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any*, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of

the world was always ready at hand and easy to be seen by a merely skilful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not."

Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428, 55 L. Ed. 527-531.

"Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit."

Webster Loomis Co. v. Higgins, 105 U. S. 580, 591, 26 L. Ed. at 1181.

We submit that this court is not going to decide this case upon mere speculation. Like any other law suit, the case is to be determined upon proofs. The proofs here are that the Wright invention comprises a new combination of elements and serves a new function not met by any prior patent or device. The fact that between the issuance and production of the prior patents and devices (Crompton 1893, Capek 1893, Simplex 1904) and the Wright invention in 1915, no one derived from the prior art the Wright invention demonstrates that it was not obvious. Mr. Wright created a new combination of elements providing a new and useful device. It would be manifestly unjust to revoke the protection granted him for his creation on the ground that for twenty years prior thereto somebody *might* have had the same conception.

“Like a jewel lost in a crowded thoroughfare, —multitudes pass it unnoticed, some actually tread upon it, others stop and gaze for a moment, but hurry on deeming it some worthless tinsel; at last comes one who recognizes its value and picks it up. Others might have done this, it is true, but they did not; he did, and is entitled to the prize which he has rescued from the mire. If one should attempt to snatch the gem from the finder on the ground that he passed it frequently and could have picked it up as well as not, he would in all probability be promptly turned over to the police as a thief or a lunatic. It is this capacity for accomplishing results, this faculty of seeing what others fail to see and hearing what others fail to hear which has always distinguished success from failure and the inventor from the mechanic.”

George Frost Co. v. Cohn, 112 Fed. 1009.

The Defendant's Device.

The interlocutory decree herein adjudges:

“That the defendant has infringed claims 6, 7, 8 and 9 of said letters patent by selling devices like Plaintiff's Exhibit 2 herein.” [Rec. p. 178.] It is stipulated that defendant sold Plaintiff's Exhibit 2 subsequent to the issuance of the patent in suit. Before passing to a discussion of infringement of the patent by Exhibit 2 we will discuss the construction and operation thereof.

An inspection of the infringing waffle iron, Exhibit 2, shows at once that the same is constructed with

a pair of casings. These casings are pivotally connected together by a pair of hinges. This much is admitted and Mr. Lamb has so testified:

“XQ. 130. Now, the waffle irons manufactured and sold for your company include a pair of casings pivotally connected together, do they not? A. They do.” [Rec. p. 56.]

An aluminum waffle baking member is mounted in each of the said casings. This is also admitted, for Mr. Lamb testifies:

“XQ. 131. And each of them includes a waffle member provided with aluminum baking surfaces mounted on each of those casings, do they not?

A. They do.” [Rec. p. 56.]

These aluminum waffle members are formed with flanges so that each of them covers the upper edge of its respective casing. There can be no dispute as to this, and Mr. Lamb testifies:

“XQ. 132. And those aluminum baking surfaces are so formed that each of them covers the upper edge of their respective casings, do they not?

A. They do.” [Rec. p. 56.]

An electric heating element is annexed to the underside of each of the waffle-baking members in the infringing device. Appellant has questioned whether or not it can be said that this electric heating element is mounted in the casing between the casing and the waffle member. It is perfectly obvious that the element is in fact surrounded by the casing and is between the waffle member and the casing. Is that enough

to be included within the term “mounted” in the casing? Appellant asserts that to be thus “mounted” the heating element must be held up directly from the bottom of the casing, and points to the fact that in the Wright device the heating element n^2 is held up adjacent to the underside of the waffle-baking member by a layer of insulating material n^1 which is laid on the bottom of the casing. The Standard Dictionary defines “mounted” as:

“Equipped or furnished with suitable requisites.”

We submit that, whether the heating element be maintained in the casing by affixing it to the underside of the waffle member or by supporting it on a layer of insulating material laid on the bottom of the casing, the heating element is *mounted in the casing*. In any event the difference is a mere mechanical detail and one manner is the obvious equivalent of the other. Both methods were alternately used in the art for years before the Wright invention. The Capek patent, issued in 1893, illustrates in figures 1 and 7 electric heating elements affixed to the underside of a cooking surface within a casing. As early as 1893 it was common in the art to refer to such affixing or suspending as “mounting,” for in the Capek patent it is thus described:

“Fig. 2 is a bottom view of the vessel on which the heater proper is mounted.” [Rec. 268, lines 21-23.]

In defendant's device there is a non-conducting or insulating element spacing the electric heating element from the casing. This non-conducting element in Exhibit 2 consists of isinglass or mica. This isinglass or mica consists of two pads positioned one on each side of the electric heating element. These pads insulate the heating element from the casing and waffle baking surface. The heating element and insulating pads are secured in position by a metal plate. This metal plate is directly suspended from the waffle baking member, but is primarily supported by the casing as the casing supports the baking member. One part is spaced from another part electrically when it is insulated therefrom. The mica pads in combination with the plate insulate and separate the electric heating element from the casing. When carefully considered it will be found that Exhibit 2 and the Wright patent disclose means for mounting and insulating the electric heating elements which perform the same function in substantially the same manner. In both devices the elements are, in fact, supported in the casing by the casing. Both manners of supporting the element are properly in the art described as "mounting." In patent law, names of things are not controlling and as they function identically they are regarded as equivalent or identical.

The operation of defendant's device, Exhibit 2, is the same as that of the Wright invention expressed in the claims in suit and as embodied in Exhibits 3 or 6. The electrical heating elements being adjacent

the undersides of the aluminum waffle baking members pass their heat directly into said members. The latter being of aluminum efficiently and immediately pass the heat to the waffle batter. Because of the low heat conductivity of the thin steel casings compared to the aluminum cooking members practically all the heat will be passed to the waffle batter and only an inconsequential proportion radiated and dissipated. Thereby Exhibit 2 may be operated on a house current. The baking surfaces being of aluminum, grease is unnecessary if the iron be properly handled. The aluminum flanges support the baking members on the casings, relieving the screws of the majority of that duty, insure that the batter and waffle will not adhere to the edges of the casings, and prevent the batter from penetrating inside the casings and disturbing the heating elements or insulation.

It is clear in view of the above that defendant's infringing device embodies each and all of the elements and advantages embodied in Mr. Wright's generic conception of the fundamental combination of elements adapted to provide an electrically heated waffle iron for table use.

Infringement.

Having pointed out the features which are possessed alike by the Wright invention and by the infringing device let us now consider whether in incorporating those features defendant has made use of the invention covered by claims 6-9 of the patent in suit. This

question may be much simplified by remembering that it is not the drawing or the specification of the patent in suit that may or may not be infringed. It is the claims that are to be considered.

“Strictly speaking, infringement of a patent is an erroneous phrase; what is infringed is a claim, which is the definition of invention, and it is the claim which is the cause of action.”

Fulton Co. v. Powers Regulator Co., 263 Fed. 578 at 580 (C. C. A. 2d.).

We have heretofore pointed out the generic character of claims 6-9 as distinguished from specific claims 1-5. The latter purport to cover the specific form illustrated in the drawing and are limited to the application of the Wright waffle iron to an electric grill. Claims 6-9, on the other hand, make no mention of a grill and are not limited thereto. The issue of infringement here is whether or not defendant infringes either or all of claims 6-9. The trial court held that claims 6-9 read precisely on defendant's device and that defendant's device was precisely the same as everything recited in such claims.

“The defendant's device being in every way the same as that *claimed* by the plaintiff in his last four claims, the mere difference in the construction of the electrical appliance or attachment as above stated does not avoid infringement.” [Rec. 176.]

We shall first consider claim 6 and thereafter take up claims 7-9 in so far as they differ from claim 6. Claim 6 reads as follows:

“6. In a device of the class described, a pair of casings pivotally connected together, a waffle member provided with an aluminum baking surface mounted in each of said casings so that each of said aluminum baking surfaces covers the upper edge of one of said casings, and means mounted in said casings between said casings and said waffle members for electrically heating said waffle members.”

It is apparent from the study of this claim that it covers, in combination, precisely those features which are common to the specific embodiment of the Wright invention illustrated in the patent drawings, to the specific embodiment of the Wright invention presented by Plaintiff's Exhibits 3 and 6, and to the infringing device, Plaintiff's Exhibit 2. The same identical elements are present in each of these expressions or embodiments of Mr. Wright's invention *as defined in claim 6*.

For example starting with the first element of claim 6 “a pair of casings pivotally connected together,” these clearly appear in figure 1 of the Wright patent drawings. As before stated, Mr. Lamb admits their presence in the infringing device. [Rec. p. 56.] The next element in claim 6 is “a waffle member provided with an aluminum baking surface mounted in each of said casings.” These members are illustrated as b-c in the Wright patent drawings and Mr. Lamb admits they are present in the infringing device. [Rec. p. 56.] Claim 6 next provides “that each of said aluminum baking surfaces covers the upper edge of one of said

casings.” These flanges are clearly illustrated in figure 1 of the Wright patent (see n⁵) and Mr. Lamb admits that they are also employed in the infringing device. [Rec. p. 56.] The other and last element of claim 6 is defined therein as “means mounted in said casings between said casings and said waffle members for electrically heating said waffle members.” This refers to the electric heating elements n² in the Wright patent drawings. We have heretofore pointed out that the infringing device has electric heating element supported by metal plates adjacent the underside of the waffle members and that within the proper lexicography of the art such support is properly termed mounted within the casing.

We find, therefore, in the infringing device in combination each and every element of claim 6. Each element in the infringing device performs the same function in the same manner as in the Wright invention. Claim 6 describes defendant’s infringing device with absolute accuracy.

“The infringement of a combination-patent therefore, consists in the manufacture, use, or sale of any combination in which precisely the same elements or their equivalents are united under the same co-operative law.”

III Robinson on Patents, Sec. 922.

“Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in substantially the

same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.”

Machine Co. v. Murphy, 97 N. S. 120, 24 L. Ed. 935-936.

Claim 7 differs from claim 6 in two respects. Whereas claim 6 states “that each of said aluminum baking surfaces covers the upper edge of one of said casings,” claim 7 provides that the aluminum baking members shall “extend past the edges of said casings.” We have heretofore pointed out the threefold purpose of such extension or flange, to support the baking member, to prevent the batter from adhering to the edge of the casing, and to prevent batter from penetrating the casing. Appellant urges that the wording of claim 7 requires that the flange shall *more* than cover the edges of the casings. This would be totally useless and such a construction should not be adopted if the phrase is open to another meaning. If the phrase read “extend past the *outer* edges of the casings” appellant might be right but it does not so read. The phrase is equivalent to stating—extend over or overlap the edge,—i. e., cover the edge. The wording of claim 7 obviously refers to a flange adapted to perform the three-fold function above set forth. The flanges on the waffle members in the infringing device perform every function involved just as do those in the Wright device and that is sufficient to constitute infringement under every rule of Patent Law. Claim

7 adds to claim 6 "a non-conducting element spacing said electrical heating element from said casing." We have heretofore shown that the infringing device has an isingless or mica pad held up by a metal plate thereby spacing and/or insulating the heating element from the casing. Claim 7, therefore, applies precisely to the infringing device and like claim 6 is clearly infringed by Plaintiff's Exhibit 2.

Claim 8 differs from claim 6 by adding that the casings are "box-shaped" and connected "so as to fold one upon the other." The casings employed in defendant's infringing device are box-shaped and fold one upon the other. Claim 8 also adds to claim 6 a statement to effect that each of the waffle members is provided with an outwardly extending flange "whereby said waffle members are supported on the edge of said casing and spaced apart from the bottom thereof." This is merely a clause describing one function performed by the aluminum flange and the infringing device utilizes such flange precisely as in the Wright invention. Every element of claim 8 is found precisely duplicated in the infringing device.

Claim 9 is identical with claim 8 except that claim 9 defines the electrical heating means in the same manner as does claim 7. Claim 9, therefore, describes exactly the combination of elements found in defendant's device.

The case, therefore, presents the situation of the infringing device embodying element for element the

combination recited in each of claims 6-9 in suit. In the infringing device each element performs the identical function in the same way as the corresponding element of the claims. The claims are the definition of the invention covered by the patent. Clear infringement of claims 6-9 appearing, it follows that defendant has infringed the patent as decreed. As has been recently said by the Supreme Court, referring to the claims of a patent:

“It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, the exclusive use of which is given to the inventor by the grant provided for by the statute.” (Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 510, 61 L. Ed. 871.)

Notwithstanding the fact that claims 6-9 find their exact counterpart in the infringing device appellant strenuously urges that the patent in suit is not infringed. Under subdivisions (a) (f) beginning at page 21 of its brief appellant has presented certain propositions in an effort to support its assertion of non-infringement. We believe the trial court's conclusion to the effect that defendant's device is “in every way the same as that claimed by the plaintiff in his last four claims” is obviously correct, but we will proceed to answer the matters asserted by appellant in the order presented in its brief.

(a) Under the assertion that the claims should be construed with regard to the drawings and specification of the patent in suit appellant endeavors to have this court discard the claims and adopt the drawing and specifications of the patent as defining the metes and bounds of the monopoly conferred thereby. This, is not a proper application of the rule advanced by appellant. It is permissible to refer to the specification and drawings to ascertain the meaning of a phrase in a claim, but the claim is the definition of the monopoly. Otherwise a patent could only cover the single embodiment of the inventor's conception. There would be no object in having claims in patents. The specification under the law sets forth one embodiment of the invention. The claims are to define that invention in whatever concrete form expressed. As said in *National Tube Co. v. Marks*, 216 Fed. 507 at 515 (C. C. A. 6th):

“The claims are part of the description required by statute, and in them, and not in that part of the description which is now commonly called ‘specification,’ is the proper place in which to define the breadth of the invention, as was most accurately apprehended by Fell’s solicitor when he (though quite unnecessarily) said that various changes might be made ‘without departing from my invention as defined by the appended claims.’ ”

In *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 52 L. Ed. 1122 at 1128 the Supreme Court states:

“In other words, he filed a description of his invention, explained its principle, and the best mode in which he ‘contemplated applying that principle’ and did not intend to give up all other modes of application. An inventor must describe what he conceives to be the best mode, but he is not confined to that. If this were not so most patents would be of little worth. ‘The principle of the invention is a unit, and invariable; the modes of its embodiment in the concrete invention may be numerous and in appearance very different from each other.’ 2 Robinson, Patents §485. The invention, of course, must be described and the mode of putting into practical use, *but the claims measure the invention.*”

We have heretofore shown that the claims are not limited to the particular manner in which the heating elements are positioned within the casings. The lengthy dissertation indulged in by appellant on the use by Wright of the casings as a box and the use by appellant of the casings to “screen or cover” the heating elements and associated parts resolves simply into the fact that appellant holds the heating element up by a metal plate annexed to the sides of the casing and Wright holds the heating element up by a layer of insulation positioned in the casing. No difference in function results. In both constructions the casing encloses the element and through the metal plate in one case and through the insulating layer in the other maintains the heating element adjacent the cooking

surface. The whole matter is one of the most immaterial of mechanical details. So far as infringement is concerned the distinction is inconsequential because the claims in suit make no mention of such mere detail.

“Bearing in mind that there is *nothing in the claim* limiting it to a straight wall or to round tenons or straight tenons, we are of the opinion *that infringement has been established.*”

Sanitary Fireproofing & Contracting Co. v.
Sprickerhoff, 139 Fed. 801 at 804 (C. C. A.
2d).

We have heretofore shown the falsity of the contention that the Wright invention is inoperative unless the casings be pivotally connected together through a grill member. This is based on the false theory that the Wright invention can only be embodied in the composite grill device illustrated in the patent drawings. Plaintiff's Exhibits 3 and 6 entirely disprove such contention. In fact so far as being adapted for baking waffles is concerned, it makes no difference if the casings be directly hinged together in the composite device. Appellant's attempt to limit claims 6-9 to a device having a grill member is contrary to well-settled law. Since these claims do not mention the grill member the claims cannot be construed under the law to include the same:

“The rules applicable to the construction of these claims in this regard are, first, that *we cannot read into a claim for a combination an ele-*

in the specification; and, secondly, that if the claim includes an element in general terms, and refers to the specification to identify it, we may read that element into the claims—a rule of construction applicable to all written instruments; and, thirdly, that where the applicant for a patent in one claim makes no mention of an element, and in another includes it, the presumption is that he omitted it in the first on purpose.”

Duncan v. Cincinnati Butcher Supply Co., 171
Fed. 656 at 663 (C. C. A. 6th).

In Mast Foos & Co. v. Dempster Mill Manufacturing Co., 82 Fed. 327 at 333 (C. C. A. 8th) the court applied the same rule as follows:

“There is not an element in this combination which is not found in the windmill of the appellee, and it cannot be permitted to read other elements into this claim, and then to defeat it, because it does not use the elements it interpolates.”

Claims 1-5 of the Wright patent include the grill member and it was the special office of those claims to protect the specific form of the Wright invention employing the grill member. The grill member was purposely omitted from claims 6-9 in suit so that the latter claims might cover other specific forms in which the Wright invention may be embodied and particularly devices like Plaintiff's Exhibits 3 and 6. It would render claims 6-9 mere duplicates of claims 1-5 to restrict the former to the grill member. It is well established that generic claims will not be restricted

to features set forth in specific claims of the same patent. In *Los Angeles Art Organ Co. v. Aeolian Co.*, 143 Fed. 880, at 885, this court said:

*“The claims of a patent should be construed, where they reasonably may be, to cover the entire invention of the patentee; and where a patent contains several claims, some of which are limited to details, the others are, prima facie, not to be restricted by insisting that they contain, as necessary elements, the particulars which are specifically covered elsewhere. The general rule is, as stated by the court in *Risdon I. and L. Works v. Trent*, 92 Fed. 375, 388, that ‘Infringement cannot be avoided by reading into a broad claim of a patent specific devices claimed in narrower claims of the patent’ ”*

(b) Appellant next urges that the fact that defendant’s device performs the same function or effect as that of plaintiff does not establish infringement, but that such effect must be produced “by substantially the same mode of operation.” As appellant does not attempt to show wherein the mode of operation of the infringing device in any manner differs from that of the Wright invention as defined in claims 6-9 in suit, we fail to perceive the pertinency of the reference. The effect produced or function performed by both devices is to bake waffles on a house current in a manner fitting the device for table use. This is made possible in both defendant’s and plaintiff’s devices by an identical combination of elements. These elements co-act in the same manner in each of the

devices. There is identity of elements and mode of operation and this identity makes possible identity of function.

(c) Under this subdivision appellant reargues its contention that the Wright casings are utilized as “boxes” for a different purpose than that performed by the casings in the infringing device. We have heretofore pointed out that claims 6-9 are not in any manner limited to such mere mechanical detail. There is absolutely nothing of substance in the distinction. In each of the devices the casings support the waffle members and enable the same to be folded upon each other for the baking operation. In each of the devices the casings enclose and protect the heating elements and insulation. The advantages and benefits of the Wright invention as defined in claims 6-9 have all been taken by defendant in its device.

Williams v. Kaufmann, 259 Fed. 859 at 863
(C. C. A. 9th).

Appellant urges at page 26 of its brief that the claims should be narrowly construed on the ground that the Wright invention ranks as an improvement over the prior art. The decree of the trial court is in entire harmony with the rule. The trial court expressly ruled that “the claims should be narrowly construed.” [Rec. p. 174.] We do not ask that this court grant to claims 6-9 any broad range of equivalents. The scope of those claims is not an issue in this case because as found by the trial court defend-

ant's device is "in every way the same as that claimed by the plaintiff in his last four claims." [Rec. p. 176.] Where an invention has been bodily appropriated as in this case, the court will protect the patentee whether the invention be broad or narrow. It is no answer for one who has taken element for element of an invention, as defined in the claims in suit, to assert that the invention is narrow. If the invention is narrow there is less excuse for infringement because it should be relatively simple to find something else. The trial court perceived this fact and stated herein:

"Now, if the defendant is of the opinion that these boxes are but a finishing, a screen or cover, it seems to the court that the defendant might devise something else." [Rec. p. 176.]

The Circuit Court of Appeals for the Second Circuit in *Rajah Auto Supply Co. v. Emil Grossman Co.*, 188 Fed. 74, said:

"The invention is, of course, a narrow one, but it belongs to that large class where the courts have sustained improvements over the prior art, which produce a new and beneficial result that materially advances the art to which they belong. When a defendant persists in using such an improvement in preference to prior devices which he insists are equally efficacious, he tacitly concedes its superiority. It is difficult to reconcile his persistent use, even though it involves him in an infringement suit, with the contention that other devices which he is free to use are equally good."

(d) Beginning at page 26 of its brief appellant refers to the rule that the fact that two devices perform the same result does not establish infringement. This is a mere restatement of the matter discussed by appellant under section (b). We have heretofore shown that the similarity between the infringing and plaintiff's devices is not confined to similarity of function or result. Defendant's device is adapted to perform the novel function of the Wright invention by employing in identical combination each and every element and attribute of plaintiff's invention as defined in claims 6-9 in suit.

(e) Under a heading "The prior art demonstrates non-infringement" and beginning at page 29 of its brief appellant again reverts to the fallacious proposition that the patent in suit should be restricted by a hypothetical device mentally organized by a combination and reorganization of prior patents and devices. We have heretofore referred to the fact that such a contention has been oft repudiated by this court and by innumerable other courts including the Supreme Court of the United States.

At page 18 of its brief appellant alleges that Landers, Frary & Clark developed the infringing device without knowledge of the Wright patent and quotes from the oral testimony of Mr. Lamb. The quoted answer of Mr. Lamb appearing at page 59 of the record was properly stricken out by the trial court. [Rec. p. 151.] The other quoted matter was properly objected to.

assertion. It is elementary that matters of asserted dates of production of devices in issue must be definitely established. No effort was made to prove the fact. Admittedly the infringing device was developed after the Wright patent was of public record. Defendant's intent is immaterial:

“To constitute an infringement of a patent, it is not necessary that the infringer should have known of the existence of the patent at the time he infringed it.”

Walker on Patents (5th Ed.), page 464.

(f) Appellant contends there is no infringement because the negotiations with the Patent Office for the patent in suit “forces upon the claims limitations not included in defendant's device.”

We have already pointed out that defendant's device presents exactly the combination as defined in claims 6-9, respectively. This is not a case where to make out an infringement the patentee must seek such an interpretation of the patent claim *as granted* as will make such claim cover the same scope as defined in a claim presented, disallowed and withdrawn during the preliminary negotiations settling the terms of the grant. Using the example selected by appellant—claim 7 presented, disallowed and cancelled, defined the invention as “a pair of waffle members pivotally connected together and means for electrically heating each of said pair.” Merely applying an electric heating element *in any manner* to each of the pans of the old well known Griswold waffle iron of commerce would

respond to such a definition. Correctly the Patent Office held [Tr. Rec. p. 294]: “The application to a waffle iron of an electric heater is not considered patentable broadly” etc. Appellee then defined his invention as set forth in claims 6-9 whereupon the application was allowed.

Appellant has not merely applied an electric heater to a waffle iron. On the contrary appellant has (as defined in claim 6) provided a pair of casings pivotally connected together, mounted in each of said casings a waffle member provided with an aluminum baking surface, extending such surfaces so that they cover the upper edges of the casings, and then mounted in the casings electric heating elements between the bottoms of the casings and the waffle members. Such a comparison demonstrates that appellant’s contention is not within the rule of law asserted by appellant and a discussion of such asserted rule becomes moot. Appellant is condemned as an infringer by the very terms of the claim as granted. There is no attempt on the part of appellee to, and the District Court did not, “claim the benefit of his (appellee’s) rejected claims, *or such a construction of his present claim* as would be equivalent thereto.” (Italics Appellant’s Brief, p. 35.)

The rule of law referred to by appellant does not fit the case. It is common knowledge that changes in the claims must be made and are always made during the negotiations with the Patent Office. The

is simply that no subsequently granted claim can be interpreted to have the identical scope of a rejected withdrawn claim.

National Hollow B. B. Co. v. International Co.,
106 Fed. 693 at 714;

Weber Elec. Co. v. Union Elec. Co., 226 Fed.
482, 485;

Wayne Mfg. Co. v. Benbow Brammer Mfg. Co.,
168 Fed. 271;

National Tube Co. v. Mark, 216 Fed. 507.

The true rule is expressed by Circuit Judge Sanborn in *J. L. Owens Co. v. Twin City Separator Co.*, 168 Fed. 259 at page 268 (C. C. A. 8th):

“If a patentee acquiesces in the rejection of his claim on references, he may be estopped to maintain that an amended claim covers the combinations shown in those references, or that it has the breadth of the rejected claim, *but he is not estopped from claiming and securing by the amended claim every improvement and combination which he has invented* and which was not disclosed by those references.”

Appellee acquiesced in the ruling of the Patent Office that merely to apply an electric heating element to each of the well-known pans of the old waffle iron did not amount to invention. But appellee did assert and “claim” and the Patent Office granted that appellee’s invention embraced the pair of pivoted casings in which the waffle members were mounted with their aluminum baking surfaces extended to cover the upper

edges of the casings, and the mounting within these casings of the electric heating elements. The distinction between merely (in any manner whatever, without specifying any manner) applying electric heating elements to the pans of the well-known waffle iron and the use of the pivoted casings, mounting of the waffle members therein, etc., of claims 6-9 is plain. Yet appellant has used the precise combination of pivoted casings, waffle members mounted therein, etc., of these claims.

It is claims 6-9 *as granted* that appellant infringes. Since appellant infringes these claims *as granted* it can gain no advantage from the fact that during the negotiations for the patent other and *different* claims were disallowed and withdrawn.

At page 50 of its brief appellant urges that the lack of commercial exploitation of the Wright invention by plaintiff is a factor to be considered. It is established that the Wright invention is successful in operation. As embodied in the waffle iron *per se*, Plaintiff's Exhibits 3 and 6, the Wright invention was successfully used from 1915 to the date of the trial hereof. [Rec. pp. 75, 80, 104.] As embodied in the composite device Plaintiff's Exhibit 5 it was also successfully used. [Rec. p. 79.]

It is established by the record that the reason plaintiff has not more extensively marketed his invention is due to no defect therein. Plaintiff organized a corporation to manufacture devices embodying his invention and had secured a factory site and ordered

some material, but just as the plans were complete the principal financial backer very suddenly died. This delayed the proposition pending a settlement of the deceased man's estate and interest. Matters had been arranged to start up again when the infringing device was brought out on the market and before plaintiff could proceed it was necessary for him to protect the grant given him by the patent in suit. Upon settlement of this suit plaintiff and those interested with him stand ready to proceed. [Rec. pp. 86-88.] Manifestly, it would be unjust to permit this delay to militate against plaintiff when it is brought about by defendant's continued infringement. Mr. Wright's testimony is corroborated by an assignment from him to Quince C. Crane [Rec. 220]; by an assignment from Wright & Crane to Crane & Wright Electric Company [Rec. 222] and by an assignment from Crane & Wright Electric Company by Wright & Mark, trustees, to plaintiff. [Rec. p. 225.] The latter assignment was made pursuant to section 13 of Act 756 of the General Laws of California. Wright and Mark being the surviving directors became the trustees pursuant to said Act for the defunct corporation. [Rec. pp. 88-95.]

The commercial value of the Wright invention is established by the defendant's verified statement showing sales of 1120 infringing waffle irons [Rec. p. 193] and by defendant filing a bond for \$8,960.00 to continue selling the same pending this appeal. [Rec. p. 196.]

In any event:

“The validity of the patents is not affected by nonuser of the patented devices, if they have utility in the sense of being capable of successful mechanical operation. Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 28 Sup. Ct. 748, 52 L. Ed. 1122; Lewis Machine Co. v. Premium Mfg. Co., 163 Fed. 954, 90 C. C. A. 310 (Reed v. Hughes Tool Co., 261 Fed. 192 at 194 C. C. A. 5th).”

Conclusion.

Appellant asks what is the advance made by plaintiff over the prior art. This advance is defined by claims 6-9 in suit. These claims are for a novel combination of elements. This combination gives to the art for the first time an electrically heated waffle iron adapted for table use. This combination is not found in any prior patent or device. It is this precise combination that defendant has appropriated in the infringing device.

This suit presents the not unusual situation of a defendant giving the tribute of its praise to the prior art but, to the plaintiff's patented invention, the tribute of its imitation.

As said by the Supreme Court, in the case of Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 441:

“The prior art was open to the rubber company. That ‘art was crowded,’ it says, ‘with numerous

they, it is insisted, possessed all of the qualities which the dreams of experts attributed to the Grant tire. And yet the rubber company uses the Grant tire. *It gives the tribute of its praise to the prior art; it gives the Grant tire the tribute of its imitation; as others have done.* And yet the narrowness of the claims seemed to make legal evasion easy. Why, then, was there not evasion by a variation of the details of the patented arrangement? *Business interests urged to it as much as to infringement.* We can find no answer except that given by the tire company: 'The patented organization must be one that is essential.' "

We submit that the decree below enjoining appellant from continuing to sell waffle irons like Plaintiff's Exhibit 2 herein was according to law, according to equity and good conscience, and in accordance with the facts, and should be affirmed.

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